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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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| In re Application of | |
| Gary KEORKUNIAN et al. | Examiner: Not yet assigned |
| Serial No.: 09/753,714 | Group Art Unit: 2152 |
| Filed: January 4, 2001 | Atty. Dkt. No. 109246.00103 |
| Confirmation No.: 2653 | |
| For: SYSTEM AND METHOD FOR ANONYMOUS OBSERVATION AND USE OF PREMIUM CONTENT | |



**PETITION TO MAKE SPECIAL**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants hereby petition to make the above-captioned application special under the special examining procedure set forth in 37 C.F.R. §1.102 and MPEP §708.02 on the ground that pre-examination searches have been conducted by the U.S. Patent and Trademark Office in its role as a PCT International Searching Authority (ISA/US) and by Applicants' attorney. Applicants respectfully submit that each of the searches constitutes an independent ground for the granting of the present Petition. The required fee is submitted herewith.

Applicants respectfully submit that all of the claims now presented in the above-captioned application are directed to a single invention. However, if the Office determines that all the claims now presented are not directed to a single invention, Applicants will make an

election without traverse.

**I. PCT Search**

In corresponding PCT international patent application No. PCT/US01/00192, the ISA/US mailed an International Search Report on May 2, 2001. According to the International Search Report, the Examiner conducted the search in U.S. Class 707, subclass 1. The Examiner cited the following U.S. patents, which were made of record in the present application in the Information Disclosure Statement filed October 18, 2001.

| Number | Applicant | Issue date |
|---|---|---|
| 5,961,593 | Gabber et al | October 5, 1999 |
| 6,173,311 | Hassett et al | January 9, 2001 |
| 5,742,762 | Scholl et al | April 21, 1998 |
| 5,768,391 | Ichikawa | June 16, 1998 |
| 5,729,537 | Billström | May 17, 1998 |
| 5,673,322 | Pepe et al | September 30, 1997 |
| 5,550,984 | Gelb | August 27, 1996 |

The first three references were cited as "X" or "Y" references, while the last four were cited as "A" references only.

However, in the PCT International Preliminary Examination Report mailed November 20, 2001, the IPEA/US noted the following:

> Claims 1-8 meets [*sic*] the criteria set out in PCT Article 33(4), because the prior art does not teach or fairly suggest a system for allowing a user to access content from a provider to process a server for establishing a first connection to the user and a second connection to the provider to access the content and a database for maintaining accounting information for the user and for the provider wherein the server communicates with the provider over the second connection to retrieve the content to be accessed by the user without disclosing identifying information about the user to the provider.

In short, it is the opinion of the IPEA/US that the present claimed invention is patentable

over the prior art found in the international search.

Applicants agree with the finding of the IPEA/US. *Gabber et al* teaches anonymous Web browsing by using substitute identifiers, as well as anonymous commerce between the users and the sites. Since the reference places great emphasis on the use of the substitute identifiers to allow personalized access, the reference teaches away from the present claimed invention, in which no identifying information is disclosed. In addition, there is no teaching or suggestion that the database maintains accounting information for the user and for the provider. Instead, it appears that the sites simply collect payment from the central proxy system, although no further details of the accounting are provided. Nor does *Gabber et al* teach the further limitations of claims 2-8.

*Hassett et al* is cited against present claim 2 for teaching of a caching proxy server. However, since *Hassett et al* does not overcome the above-noted limitations of *Gabber et al,* the combination of those two references would not have taught or suggested the present claimed invention.

*Scholl et al* is cited against present claim 5 for teaching that a Web server can log information regarding requests for information, including the Internet address, the time and the information requested. However, *Scholl et al* does not teach or even remotely suggest that the server measures an *amount of time,* as called for in present claim 5. Nor does *Scholl et al* overcome the above-noted deficiencies of *Gabber et al.* Therefore, the combination of those two references would not have taught or suggested the present claimed invention.

In summary, the present claimed invention is patentable over the references cited in the

International Search Report and over any combination thereof.

**II. Search by Applicants' Attorney**

Applicants' attorney performed a keyword search through the online databases of the U.S. Patent and Trademark and the IBM Intellectual Property Network for U.S. patents and published patent applications from the Japanese Patent Office, the European Patent Office and the World Intellectual Property Organization relating to time limits or promotions on the World Wide Web. Applicants' attorney also performed a keyword search through several Internet search engines for the same concepts.

The search uncovered the following references, copies of which were made of record in the present application in the Information Disclosure Statement filed October 18, 2001.

| Issuing Authority | Number | Applicant | Issue date |
|---|---|---|---|
| U.S. | 5,774,869 | Toader | June 30, 1998 |
| U.S. | 5,806,043 | Toader | September 8, 1998 |
| U.S. | 5,812,769 | Graber et al | September 22, 1998 |
| U.S. | 5,819,285 | Damico et al | October 6, 1998 |
| World Intellectual Property Org. | 99/09725 | Greenspan et al | February 25, 1999 |

The *Toader* patents teach a technique for providing sponsor-paid Internet access for promotional purposes, for a limited time with a user-paid refresh option. The sponsor distributes access software and a PIN to the user. The user uses the software to access a server and the PIN to log into the server. After a registration process in which the user is asked questions for marketing purposes and a guided tour of the sponsor's Web site, the user is free to use the remaining time as desired, although the server keeps track of the sites which the user visits. Once the time is up, the user can refresh the account.

*Graber et al* and *Damico et al* teach techniques for monitoring a user's Web browsing. A user accesses a home page 128 of an online service 140 by clicking on an advertisement on one of three co-marketer sites 122*a,* 122*b,* 122*c.* Each advertisement is linked to a URL which identifies the home page 128 and also identifies to the online service 140 the identify of the co-marketer site 122*a,* 122*b* or 122*c* which referred the user. The online service 140 tallies the number of users from each co-marketer, and each co-marketer is paid through a billing server 143 in accordance with the number of users tallied. The online service 140 includes an enrollment means 145 which assigns the user a unique identifying code, asks the user to enter various personal information and offers the user to choose from among several membership plans including a free trial membership. The enrollment means downloads the software needed to access the online service onto the user's computer, unless that software has already been downloaded.

*Greenspan et al* is cited as being of general interest in that it teaches connecting a host server to a destination server through a stream manager.

The present claimed invention includes subject matter which is patentable over the prior art found in the search. In *Graber et al* and *Damico et al,* the assignment of the unique identifying code and the management of the free trial account are carried out by the online service itself, not by the co-marketers or by any server and database such as those defined in the present claims, and only when the user elects to go through the registration process.

Also, while the co-marketers have hypertext links to the online service, communication between the user and the online service does not take place through the co-marketers. Neither of

those patents makes any provision for users who wish to have their free trial periods before registering and divulging personal information.

If the online service of either of those patents were modified to allow free trial periods without registration, there would be no effective way to prevent everyone from using an indefinite number of "trial" periods except for the online service itself to assign trial passwords, as taught by *Toader,* in which case the co-marketers would be superfluous and the online service would assume an additional administrative burden. Moreover, the present claimed invention, unlike *Graber et al, Damico et al* and *Toader,* does not require the user to install any special software.

The present claimed invention is plainly not anticipated by any of the references found in the search. Moreover, the present claimed invention would not have been obvious over any of the references or over any combination thereof.

**Conclusion**

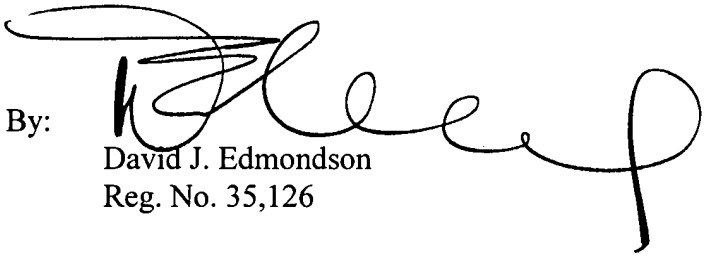
Each of the searches described above provides an independent reason for the granting of the present Petition. Neither of the searches uncovered any reference or references that anticipate the present invention or that, alone or in combination, would have rendered the present invention obvious. In fact, as described above, both of the searches uncovered references that teach away from the present invention.

For the reasons set forth above, Applicants respectfully submit that the above-captioned application should be made special. Notice that the above-captioned application has been made special is earnestly solicited.

Please charge any deficiency in fees, or credit any overpayment thereof, to BLANK ROME COMISKY & McCAULEY LLP, Deposit Account No. 23-2185 (109246.00103).

Respectfully submitted,

Gary KEORKUNIAN et al

By: 

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